



# UNITED STATES PATENT AND TRADEMARK OFFICE

cd

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/754,450	01/04/2001	Dustin Fasbender	4662US(300-016)	3636

4743 7590 11/25/2003

MARSHALL, GERSTEIN & BORUN LLP  
6300 SEARS TOWER  
233 S. WACKER DRIVE  
CHICAGO, IL 60606

EXAMINER
----------

NGUYEN, KIM T

ART UNIT	PAPER NUMBER
----------	--------------

3713

DATE MAILED: 11/25/2003

13

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/754,450

Applicant(s)

FASBENDER ET AL.

Examiner

Kim Nguyen

Art Unit

3713

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 03 September 2003.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 101-127 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 101-127 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. §§ 119 and 120**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All   b) ☐ Some \*   c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)                      4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)                      5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 10                      6) ☐ Other: \_\_\_\_\_

Art Unit: 3713

### DETAILED ACTION

The amendment filed on September 3, 2003 (paper No. 12) has been received and considered. By this amendment, claims 1-100 have been canceled, claims 101-127 have been added, and claims 101-127 are now pending in the application.

#### *Claim Objections*

1. Claims 102, 104, 106-107, 112, 115-117, and 122 are objected to because of the following informalities:
  - a) In claim 102, line 2, the claimed limitation “a player” should be corrected to “the player”.
  - b) In claim 104, lines 1-2, the claimed limitation “the player” should be corrected to “a player”.
  - c) In claim 106, lines 3-4; and claim 107, line 3; the claimed limitation “the at least one selected payline” should be corrected to “at least one selected payline”.
  - d) In claim 112, line 5; claim 115, lines 3-4; claim 116, line 3; claim 117, line 3; and claim 122, line 4; the claimed limitation “at least one selected payline” should be corrected to “said at least one selected payline”.
  - e) In claim 112, line 8, the claimed limitation “said trigger” should be corrected to “said second triggering event”.
  - f) In claim 122, line 4, the claimed limitation “at least one payline” should be corrected to “said at least one payline”.

Art Unit: 3713

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 106-107 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
3. Claims 106 and 107, lines 1-2, recite the limitation " said assigning symbols to image sites along said bonus payline". There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 101-105, 111-112, 116-122 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sugiyama et al (US. Patent No. 6,547,242).
  - a. As per claim 101, 104-105, and 111, Sugiyama discloses a gaming method comprising displaying symbols on an array of images (Fig. 1), determining whether a winning combination is present along a payline (col. 8, lines 57-60), determining whether a trigger symbol is present along

Art Unit: 3713

the payline (col. 8, lines 65-66), determining whether the trigger symbol is present at a trigger site of the array (col. 4, lines 47-50), and providing an additional award (col. 7, lines 64-67, and col. 8, lines 1-6). Sugiyama does not explicitly disclose providing a bonus event and an additional bonus event. However, Sugiyama discloses offering the player chances to win additional awards (col. 7, lines 64-67, and col. 8, lines 1-6). Further, providing bonus game as a chance for winning additional awards would have been well known to a person of ordinary skill in the art at the time the invention was made. It would have been obvious to a person of ordinary skill in the art at the time the invention was made to replace chances of winning of Sugiyama with a well known bonus game in order to allow the player to continue playing another game for another award.

b. As per claim 102, Sugiyama discloses allowing the player to select a payline (col. 8, lines 52-54).

c. As per claim 103 and 120, allowing the player to select a trigger symbol and increasing an award in a bonus event would have been well known to a person of ordinary skill in the art at the time the invention was made.

d. As per claim 112, 116-119, and 121-122, refer to discussion in claim 101 above.

6. Claims 106-110, 113-115, and 123-127 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sugiyama et al (US. Patent No. 6,547,242) in view of Darby (US 2003/0130024).

Art Unit: 3713

- a. As per claim 106-107, and 110, Sugiyama discloses displaying symbols identical to the symbols on the selected payline (col. 6, lines 27-31). Further, Darby discloses permitting the player to select an image site along the bonus payline and replacing the symbol at each unselected image site with another symbol (paragraph 0033). It would have been obvious to a person of ordinary skill in the art at the time the invention was made to allow the player to select an image site along the selected payline and replacing the symbol at each unselected image site as taught by Darby in order to increase the chance of winning for the player.
- b. As per claim 108, Darby discloses displaying cards (Fig. 8, paragraph 0025).
- c. As per claim 109 and 113-115, refer to discussion in claims 106 and 108-110 above.
- d. As per claim 123, refer to discussion in claims 101-102, 105-106, and 120 above.
- e. As per claim 124-125, refer to discussion in claims 115-116 above.
- f. As per claim 126, selecting a special symbol such as "Ace of Space" as a trigger symbol would have been obvious to a person of ordinary skill in the art at the time the invention was made, since selecting a trigger symbol according to a designer's preference requires only routine skill in the art.
- g. As per claim 127, providing a draw poker game as a bonus game would have been well known to a person of ordinary skill in the art at the time the invention was made.

Art Unit: 3713

***Response to Arguments***

7. Applicant's arguments with respect to the new claims have been considered but are moot in view of the new ground(s) of rejection.

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

**Any response to this final action should be mailed to:**

Box AF

Commissioner of Patents and Trademarks

Washington, D.C. 20231

or faxed to:

Art Unit: 3713

(703) 872-9306, (for formal communications; please mark "EXPEDITED  
PROCEDURE")

Hand-delivered responses should be brought to Crystal Plaza II, Arlington. VA.,  
Second Floor (Receptionist).

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kim Nguyen whose telephone number is (703) 308-7915. The examiner can normally be reached on Monday - Thursday from 8:00 am to 5:30 pm ET. The central official fax number is (703)872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703)308-1148.

kn

Date: November 14, 2003

  
**KIM NGUYEN**  
**PRIMARY EXAMINER**